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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,718	07/18/2003	Grace Chen	124452.0002.000	2949

66558 7590 01/29/2008
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EXAMINER

CAMPEN, KELLY SCAGGS

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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01/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/622,718

Applicant(s)

CHEN, GRACE

ExaminerKELLY CAMPEN **Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application
- ☐ Other: ____.

DETAILED ACTION

Election/Restrictions

Newly submitted claim 12 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claim is distinct in that it is directed to a method that may be practiced without the system of claim 1 and would require a different search and a burden on the Examiner.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 12 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

The abstract of the disclosure is objected to because it includes inappropriate language and is in excess of 150 words as further described below. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title.

It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.**

Extensive mechanical and design details of apparatus should not be given.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (US 6282522).

Davis et al. disclose a payment system for making an electronic payment by a user to a provider via an electronic interface, the system comprising: an input device for receiving user data and a requested transaction; a receiver processing computer system removed from the input device, said receiver processing system configured to receive the user data and the transaction; transmitting network external to the input device and linking the input device to the receiver processing system, the transmitting network disposed for transmitting the user data and the requested transaction from the input device to the receiver processing system; the receiver processing computer system programmed to authenticate the user and the transaction, approve or disapprove the transaction and initiate completion of the transaction based on approval and in accordance with criteria established by the user (see col. 4, lines 30-50 and figures 5 and 10) but does not disclose specifically wherein the system is external to the computing device. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use an external device because it is well known to use the security/identification features common to

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credit/debit card and the conveniences thereof and it would be obvious to combine with a payment system as is used in check clearing as is seen in ACH settlements as there are lower fees charged to the merchants..

Specifically as to claim 2, wherein the input device is a point-of-sale terminal (see col 3 lines 23-35).

Specifically as to claim 3, wherein the input device is an ATM/POS terminal (see col 3 lines 23-35).

Specifically as to claims 4 and 5, further including a payment transaction gateway and wherein the receiver processing system is adapted for communicating with the payment transaction gateway to receive authenticated user requests (see col 13, lines 25-35).

Specifically as to claim 6, wherein the input device is connected to the receiver processing system via the Internet (see col 6, lines 15-25).

Specifically as to claim 7, further including at least one financial institution adapted for communicating with the receiver processing system and wherein the requested transaction is completed through the financial institution in accordance with criteria set by the user and managed by the receiver processing system (see col 14, lines 25-65).

Specifically as to claim 8, wherein the receiver processing system is adapted for communicating with the Federal Reserve Automatic Clearing House (ACH) system (see col 14, lines 25-65).

Specifically as to claim 9, a method for processing an electronic payment comprising the steps of: establishing authenticating criteria for a user; entering user data via an input device; entering a requested transaction at the input device; transmitting the user data and the transaction to a processing system; authenticating the user; completing the transaction in accordance with criteria

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controlled by the user but does not specifically disclose pre-established criteria (see col 5, lines 35-45, col. 9 , lines 1-15 and figures 10 and 5). It would have been obvious to one of ordinary skill at the time the invention was made to use preestablished criteria with the invention of Davis et al. as it is well known in the art to have a banking system deduct payment s from one account prior to deducting or adding to another or say for loan repayment is within the scope of the terms pre-established criteria.

Specifically as to claim 10, wherein the pre-established criteria includes establishing a hierarchy for selecting completion of the transaction from a plurality of user controlled accounts (see col. 14).

Specifically as to claim 11, wherein the transaction is completed via the Federal Reserve Automatic Clearing House (ACH) regardless of the input device (see col 11, col. 14, lines 25-65).

Examiner's Note

Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the specific pre-established criteria controlled by the user as indicated by the applicant in page 7 lines 6-16 as:

The SVP customer/user is a member of the system and will have instructed the system to handle his transactions in a specific manner. For example, the customer member may instruct the system to prioritize use of his accounts, e.g., first debiting a cash account so long as the balance stays above a specific floor, and then charging the transaction to one or more credit accounts. In addition, the system will permit customization not previously supported. For example, if the service provider is a medical clinic and the user has a health plan with a co-pay or deductible, the SVP system will permit the customer to pay for the services and automatically deduct the co-pay or deductible from a customer cash or credit account while making the remaining payment from the insurance carrier account.

as recited) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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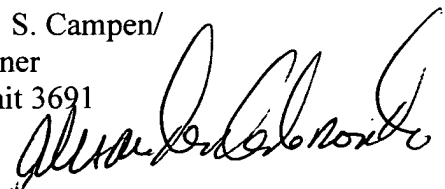
the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly S. Campen/
Examiner
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ALEXANDER KALINOWSKI
SUPERVISORY PATENT EXAMINER

/ksc/